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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,126	12/29/2003	John F. Kilroy	3330/77	1733
29858	7590	12/14/2006	(LOT9-2003-0061-U)	
THELEN REID BROWN RAYSMAN & STEINER LLP 900 THIRD AVENUE NEW YORK, NY 10022			EXAMINER WILLIAMS, KENT L	
			ART UNIT	PAPER NUMBER
			2112	

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/748,126

Applicant(s)

KILROY, JOHN F.

Examiner

Kent L. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10 August 2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: There is no period at the end of the sentence on page 3, line 2. The sentence on page 8, line 12 reads "the a setProp" that should read "the setProp."

Appropriate correction is required.

2. The use of the trademark "Java™" among others found on page 4-5 has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," "Disclosed," etc.

### ***Claim Objections***

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 3-40 been renumbered 2-39.

The dependencies of these claims were respectively shifted, with the exception of (original) claim 24's dependency. The rest of this detailed office action will refer to the renumbered claims and their renumbered dependencies.

5. Claims 2, 15 and 28 are objected to because of the following informalities: "points correspond one or more methods" should be "points corresponds to one or more methods." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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7. Claims 1-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Sirer et al. (U.S. Patent No. 6,865,735).

Sirer et al. teach claims 1, 14 and 27 as, "The binary rewriting engine then inserts appropriate enforcement code at or before each such location in the program or program snippet. The nature of the code that is added, e.g., for enforcement, depends upon the property that is being addressed, which may be specified in the site-specific properties database. Alternatively, the code that is added to the program or program snippet may be generated internally by binary rewriting engine 30. (Column 5, lines 40-47)." The examiner interprets Sirer et al.'s invention to anticipate merely declaring enforcement points for the declarations of the permission classes for the processor to insert authorization enforcement code within said classes enforcement point locations. A broader version of the aforementioned is illustrated within Figure 3 of Sirer et al.: Blocks 54 and 56 show the enforcement point declarations. Block 62 shows the specification of the permission classes. Blocks 64 and 66 show the insertion of the authorization enforcement code based on the declarations of the enforcement points and their respective declarations of permission classes. Sirer et al. describe the previous as, "In block 62, the logic determines the code that is necessary to be inserted into the program or program snippet to enforce the properties that are specific to the site. In addition, [...] block 64 determines where the enforcement code should be inserted within the program so that in block 66, the enforcement code can be added. (Column 7, lines 7-13)." Column 5, lines 29 through 40 further illustrate the properties that read on the instant application beyond figure 3. Please note that Sirer et al.'s

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invention's versatility is noted as, "It is contemplated that the binary rewriting server and the target host may be the same computer. (Column 4, lines 21-22)." Please also see column 4, lines 7 through 35 for further illustration of Sirer et al.'s invention's versatility not pertinent to the instant application. More specific to the instant application: "It is also noted that security properties impose restrictions on a rewritten program tending to enhance or protect system integrity. [...] ...these checks would be embedded in the code of the rewritten code by the binary rewriting engine 30, thereby obviating the need to encode the security policy into the Java [™] run time code. (Column 9, lines 13-23)."

The examiner finds the following summary to read entirely on the instant application:

"The present invention enables administrators and other users of computer systems to enforce site-specific resource usage constraints, auditing requirements, **security checks**, and other parameters on code of both known and unknown origin. In addition, the invention permits the translation of code from one source binary format to a different binary format that is suitable for the target host to execute. (Column 9, lines 38-45)."

To reiterate: "the binary rewriting server may be in the same machine as the target machine or the provider machine, thereby reducing requirements for multiple computers to carry out the present invention in very small systems. (Column 10, lines 1-5)."

Please also note claims 1, 4, 40 and 42 of Sirer et al.'s patent.

Sirer et al. teach claims 2, 3, 4, 7, 8, 9, 15, 16, 17, 20, 21, 22, 28, 29, 30, 33, 34 and 35 as demonstrated on column 7 and 8, lines 35-67 and 1-25. It is clearly shown that enforcement points, already rewritten as enforcement code

"`EnforcementManager.check(this, "fs.read");`" is clearly linked to a method

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"<method name="int read()">" of the target class "<class name="java.io.FileInputStream(String)">" using deployment descriptors on lines 5 through 25 in column 8. Please note that the aforementioned is written as script code. However, "[At] block 22 in FIG. 2 indicates that the input code is parsed in its external representation form, as originally provided. This external format might be in the form of a Java bytecode or ActiveX component. A parser produces a program or a program snippet 24 in an internal representation that typically comprises a set of rich data structures. (Emphasis added, Column 4, lines 61-67)." The examiner also wishes to further note that script code and byte code are interchangeable, where the only difference is in abstraction of the code to make it human readable – both will be deduced to machine code before execution (and perform the same operations on any one particular machine and/or platform). (Column 7, lines 38-40). Also, it would be inherent that such declarations would be either constant, local or instance variables within a deployment descriptor when written in Java™ format, as seen within the code on column 8, lines 5-25. Please see column 7, lines 54-67 and column 8, lines 26-56 for further details.

Sirer et al. teach claims 5, 6, 18, 19, 31 and 32 inherently. The examiner sees inherency throughout the specification that, if Sirer et al.'s invention is to parse the program, it must first be loaded into memory. Also, in the case when Sirer et al.'s invention is to be implemented in the form where "...the binary rewriting server [is] the same machine as the target machine... (Column 10, lines 2-3)," the parsing and authorization enforcement code insertion *will be performed at runtime*.

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Sirer et al. teach claims 10-13, 23-26 and 36-39 via inherency. The examiner finds by the mere fact that “[illustration of] the operation of the present invention for rewriting code in regard to security criteria [...] [the] process is shown [in column 8] for a stripped version of the class java.io.FileInputStream, [...] **but specification for other relevant classes**, such as java.io.FileOutputStream or java.applet.Applet **is omitted**. (Emphasis added, Column 7 and 8, lines 54-67 and 1-4).” Sirer et al. hereby teach that any java (or other language) authorization enforcement declarations and code may be used with their invention.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).



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9. Claims 1-3, 5-8 and 10-29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 09/907,848. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed (and amended claimed) subject matter of the copending application and the claimed subject matter of the instant application are both drawn to runtime insertion of authorization enforcement code and determined enforcement points within the code. The claims the instant application that align with the copending application are as follows: Claims 1, 14, 27 to 1 and 8, claim 2, 15, 28 to claims 3 and 9, claims 3, 16, 29 to claims 1 and 8, claims 5, 18, 31 to claims 1 and 8, claims 6, 19, 32 to claims 1 and 7, claims 7, 20, 33 to claims 1 and 5, claims 8, 21, 39 to claim 1, and claims 10-13, 23-26, 36-39 to claims 1, 4-9.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kent L. Williams whose telephone number is 571-272-1376. The examiner can normally be reached on Mon-Fri 7:30-5:00 with Alternate Fridays Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kent Williams  
11/30/2006

  
WALTER D. GRIFFIN  
SUPERVISORY PATENT EXAMINER